

ESTTA Tracking number: **ESTTA773753**Filing date: **09/29/2016**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Into the Void FX LLC		
Entity	Limited Liability Company	Citizenship	Minnesota
Address	17441 Glacier Way Lakeville, MN 55044 UNITED STATES		

Attorney information	GREGORY B. PERLEBERG Peterson Habicht, PA 33 South Sixth Street, Suite 3900 Minneapolis, MN 55402 UNITED STATES ipdocketing@petersonhabicht.com Phone:6128365500
----------------------	---

Registration Subject to Cancellation

Registration No	4875421	Registration date	12/22/2015
Registrant	THE VOID, LLC 405 N. 880 W. STE C LINDON, UT 84042 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2015/10/09 First Use In Commerce: 2015/10/09 All goods and services in the class are cancelled, namely: Entertainment services, namely, providing virtual environments in which users can interact for recreational, leisure or entertainment purposes


Grounds for Cancellation


Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
The mark is or has become generic	Trademark Act Section 14(3), or Section 23 if on Supplemental Register

Related Proceedings	Trademark Opposition No. 91227848
---------------------	-----------------------------------

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	86605205	Application Date	04/21/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INTO THE VOID FX		

Design Mark			
Description of Mark	<p>The mark consists of the stylized wording "INTO THE VOID" above the design of an unspooling film strip with the stylized letter "FX" below the film strip. There are streaming beams of light going up and down from the center of the film strip. An incomplete design of a planet as if seen from space surrounds the wording and design and there are stars in the background around the wording and design.</p>		
Goods/Services	<p>Class 041. First use: First Use: 2010/02/11 First Use In Commerce: 2010/02/11 Entertainment services, namely, production of digital special effects specializing in VFX including model-making services, computer-generated imagery and computer-generated graphics for the production of motion pictures, videos, television programs and movie trailers; Entertainment, namely, preparation of digital special effects specializing in VFX for film and television</p> <p>Class 042. First use: First Use: 2010/02/11 First Use In Commerce: 2010/02/11 Digital special effects design for others specializing in VFX for film and television</p>		
U.S. Application No.	87181540	Application Date	09/23/2016
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of the stylized wording "INTO THE VOID" above the design of an unspooling film strip with the stylized letter "FX" below the film strip. There are streaming beams of light going up and down from the center of the film strip. An incomplete design of a planet as if seen from space surrounds the wording and design.
Goods/Services	Class 035. First use: First Use: 2010/02/11 First Use In Commerce: 2010/12/15 Advertising and consulting services, namely, production for others of digital special effects specializing in VFX including model-making services, computer-generated imagery and computer-generated graphics, digital cinema package (DCP), 3D stereoscopic alignment, color grading, editing, motion graphics, 360/VR videos, animation, pre-roll ads, motion graphics, pre-production, pre-visualization, storyboarding, animatics, production, post-production, project workflows, hardware/software solutions, social marketing, and research and development for and related to the production of television commercials, motion pictures, videos, television programs, movie trailers, video games, toys, and internet content

Attachments	86605205#TMSN.png(bytes) 87181540#TMSN.png(bytes) Petition_for_Cancellation-_THE_VOID_Class_41_Into_the_Void_FX_LLC.pdf(193050 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/GREGORY B. PERLEBERG/
Name	Gregory B. Perleberg
Date	09/29/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 4875421 for THE VOID

Date of issue: December 22, 2015

INTO THE VOID FX LLC

Petitioner,

PETITION FOR CANCELLATION

v.

THE VOID, LLC

Registrant.

PETITION FOR CANCELLATION

INTO THE VOID FX LLC (hereinafter “Petitioner”) is a Minnesota limited liability company with its registered address located at 17441 Glacier Way, Lakeville, Minnesota. Petitioner believes that it is and will be damaged by the continued presence on the Principal Register of U.S. Registration No. 4875421 for “THE VOID” for the provision of entertainment services in International Class 41 (the “Utah Void Mark”), and hereby petitions to cancel that registration under Trademark Act Sections 2(d) and 14(1), 15 U.S.C.A. §§ 1052 & 1064. As grounds for the Petition for Cancellation, it is alleged as follows:

FACTUAL BACKGROUND

1. Petitioner operates a services company for the provision of entertainment services and digital special effects, specializing in visual effects (VFX) including model-making services (e.g., virtual digital environments), computer-generated imagery and computer-generated graphics for the production of motion pictures, movie trailers, videos, television programs and video games. Further information about Petitioner can be found on its website at <http://www.intothevoidfx.com>.
2. On February 11, 2010, Petitioner registered with the Minnesota Secretary of State office as INTO THE VOID PRODUCTIONS LLC, and was the successor in interest to certain contributions and assets created and/or controlled by Wayne H. Johnson, Jr. and John Payne, the founders of INTO THE VOID PRODUCTIONS LLC, including the graphical designs that were the basis of the INTO THE VOID FX design logo.
3. On or about August 3, 2012, INTO THE VOID PRODUCTIONS LLC was converted to a sole proprietorship owned by Wayne H. Johnson, Jr., dba INTO THE VOID FX.
4. On January 24, 2014, Petitioner registered with the Delaware Secretary of State office as INTO THE VOID FX LLC, and was the successor in interest

to certain assets and liabilities of INTO THE VOID PRODUCTIONS LLC and Wayne H. Johnson, Jr.

5. On January 29, 2016, Petitioner registered with the Minnesota Secretary of State office as INTO THE VOID FX LLC and on February 3, 2016, INTO THE VOID FX LLC, the Delaware limited liability company, merged into INTO THE VOID FX LLC, the Minnesota limited liability company which is the successor in interest to substantially all of the assets and liabilities of the Delaware entity.
6. On April 21, 2015, Petitioner filed with the U.S. Patent and Trademark Office (“USPTO”), service mark application U.S. Serial No. 86605205 (design plus words) for “[e]ntertainment services, namely, production of digital special effects specializing in VFX including model-making services, computer-generated imagery and computer-generated graphics for the production of motion pictures, videos, television programs and movie trailers; Entertainment, namely, preparation of digital special effects specializing in VFX for film and television” in Class 41, and for “[d]igital special effects design for others specializing in VFX for film and television” in Class 42.
7. On September 23, 2016, Petition filed with the USPTO service mark application U.S. Serial No. 87181540 (design plus words) for “[a]

Advertising and consulting services, namely, production for others of digital special effects specializing in VFX including model-making services, computer-generated imagery and computer-generated graphics, digital cinema package (DCP), 3D stereoscopic alignment, color grading, editing, motion graphics, 360/VR videos, animation, pre-roll ads, motion graphics, pre-production, pre-visualization, storyboarding, animatics, production, post-production, project workflows, hardware/software solutions, social marketing, and research and development for and related to the production of television commercials, motion pictures, videos, television programs, movie trailers, video games, toys, and internet content" in Class 35.

8. Each design mark consists of the stylized wording "INTO THE VOID" above the design of an unspooling film strip with the stylized letter "FX" below the film strip, along with streaming beams of light going up and down from the center of the film strip, and a design of a planet as if seen from space surrounding the wording and design and stars in the background around the wording and design (together with its internet domain name, and its prior and current trade names, collectively, the "Into the Void FX Marks").

9. Since 2010, Petitioner and its predecessors in interest have engaged in exclusive, continuous and uninterrupted use of the Into the Void FX Marks. Petitioner has incurred and expended significant funds, time, and labor to promote, market, and advertise its trademarks, brand, and related products and services, including the Into the Void FX Marks. By way of example and not limitation, Petitioner has prominently displayed its Into the Void FX Marks on client proposals, business cards, web pages, and advertising and promotional materials.
10. Upon information and belief, THE VOID, LLC (“Registrant”) is a Utah limited liability company located at 405 N. 880 W. STE C, London, Utah, that specializes in providing virtual environments in which users can interact for recreational, leisure or entertainment purposes. Further information about Registrant can be obtained at <https://thevoid.com>.
11. Upon information and belief, Registrant first registered with the Utah Secretary of State on September 25, 2014. On or about September 15, 2014, KPB, LLC, a Utah limited liability company, filed a service mark for the Utah Void Mark, consisting of the plain words “THE VOID,” with a declaration of first use anywhere of October 9, 2015.
12. KPB, LLC assigned the Utah Void Mark to Registrant on or about April 19, 2016.

13. Since 2010, Petitioner has offered Petitioner's services in the United States under the Into the Void FX Marks. Petitioner has engaged in exclusive, continuous and uninterrupted use of the Into the Void FX Marks for the provision and sale of digital special effects to others.

14. By reason of its use of the Into the Void FX Marks, Petitioner has developed and continues to develop a client base throughout the United States. The Into the Void FX Marks have also acquired meaning exclusively identified with the services of Petitioner.

15. The widespread and continuous use of the Into the Void FX Marks has resulted in making Petitioner well known for trademark purposes. As a result of internet advertising and sales, together with longstanding consumer acceptance, the Into the Void FX Marks identify Petitioner's services.

16. Petitioner has developed significant and valuable goodwill in the U.S. in the Into the Void FX Marks when used in connection with Petitioner's services. The Into the Void FX Marks are relied on by the trade and the public to identify Petitioner's services and distinguish them from the goods and services of others.

COUNT I

First Basis for Cancellation – Likelihood of Confusion and Prior Use

17. Petitioner realleges and incorporates herein by reference all preceding paragraphs.
18. Petitioner's use of the Into the Void FX Marks in the U.S. in connection with Petitioner's services is prior to the date of first use, October 9, 2015, and filing date, September 15, 2014, set forth in U.S. Registration No. 4875421. Accordingly, Petitioner has prior rights in the United States in the Into the Void FX Marks.
19. As a result of the foregoing, Petitioner will be damaged by the continued registration of the mark "THE VOID" in Registration No. 4875421 for entertainment services since such registration denies Petitioner, as the prior user and rightful owner of the Into the Void FX Marks.
20. By virtue of the identity between Petitioner's and Registrant's respective marks, the overlap in entertainment services, particularly visual effects, and clients for these services, there is a likelihood of confusion as to the source of their respective products in the marketplace. Registrant's use of "THE VOID" is confusingly and deceptively similar to Petitioner's Into the Void FX Marks.

21. Accordingly, Petitioner seeks cancellation of Registration No. 4875421 on grounds of likely confusion and prior use.

COUNT 2

Second Basis for Cancellation – Genericness

22. Petitioner realleges and incorporates herein by reference all preceding paragraphs.

23. The term “void” has been widely used by third party manufacturers, media and technology companies, entertainment providers, and is subject in over eighty live USPTO registrations and applied-for marks.

24. The term the “void” means an empty space and nothingness. The manifestation of nothingness is closely associated with the contemplation of emptiness, and with human attempts to identify and personify it.

25. The void has also become synonymous with special and visual effects.

26. As such, the concept of The Void, simply labels the services the company provides to create a Hyper-Reality with visual effects in an empty space.

27. Many companies, including Sony Online Entertainment LLC, Registration No. 4034757, Capcom U.S.A., Inc., Registration No. 3785228, have made entertainment services available under the term “void.”

28. The term “void” alone has become generic and diluted for trademark purposes. Generic marks are not protectable.

29. Accordingly, Petitioner seeks cancellation of Registration No. 4875421 on grounds of genericness.

WHEREFORE, Petitioner believes it is being or will be damaged by the continued presence on the Principal Register of U.S. Registration No. 4875421, and therefore petitions for cancellation of that Registration.

Respectfully submitted,

PETERSON HABICHT, PA

Dated: September 29, 2016

By /s/ Gregory B. Perleberg
Gregory B. Perleberg, I.D. No. 0212477
John A. Sullivan, I.D. No. 0396730
Attorneys for Petitioner INTO THE VOID FX LLC
33 South Sixth Street
Suite 3900
Minneapolis, MN 55402
PH: (612) 836-5500; FAX: (612) 836-5599
gperleberg@petersonhabicht.com
jsullivan@petersonhabicht.com

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Petition for Cancellation was served by US mail, first class, postage prepaid, and by email as indicated, on September 29, 2016 on the below:

Jared L. Cherry
Of Counsel Attorney
PHILLIPS RYTHER & WINCHESTER
124 South 600 East
Salt Lake City, UT 84102
Fax: (801) 935-4936
jlc@prwlawfirm.com

Attorneys or record for THE VOID, LLC

Dated: September 29, 2016

By /s/ Gregory B. Perleberg_____